# UNITED STATES PATENT AND TRADEMARK OFFICE

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| 10/774,809 | 02/09/2004 | Peter Fornell | 1005-7-01 USP | 9245 |

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| ART UNIT | PAPER NUMBER |
|---|---|
| 2617 | |

DATE MAILED: 12/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on <u>09 August 2006</u>.

2a) ☒ This action is **FINAL**.        2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) *1-20* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-20* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All  b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

## DETAILED ACTION.

### *Response to Arguments*

1.    Applicant's arguments with respect to claims 1-20 have been considered but are

moot in view of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 112*

2.    The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
> set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 11 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with

the written description requirement.  The claim(s) contains subject matter which was not

described in the specification in such a way as to reasonably convey to one skilled in

the relevant art that the inventor(s), at the time the application was filed, had possession

of the claimed invention. The amended claimed limitations "data structure is stored in an

internal memory", in claims 1 and 11 are not clearly described in the specification as

originally filed and this constitute new matter.  All claims that depend on the above

rejected claims are also rejected for fully incorporating the deficiencies of the above

rejected claims from which they depend. Appropriate correction is required.

*3.* The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-3, 5-7 and 11-20 are rejected under 35 U.S.C. 102(b) as being anticipated**

**by Oshima (U.S. 6,463,300), (hereinafter Oshima)**

Regarding **claims 1 and 17**, Oshima discloses a method of configuring a mobile device

in a mobile communications network, the method comprising:

determining whether a first identity module coupled to a mobile device is different

from a second identity module previously coupled to the mobile device (mobile station

10 identifies whether or not the inserted SIM card 26 is equal to the previously inserted

SIM card 26, see col. 7, lines 35-37 and Fig. 6; whereby the Sim card 26 is being

associated with the "first identity module" and the previous Sim card is also being

associated with the "second identity module");

searching entries in a data structure for first configuration data (IMSI, PIN and

telephone number a short dial data, col. 7, lines 25-35) associated with the first identity

module (various data storing in the SIM card 26 that are stored in the memory section

25 of the mobile station 10, is use to compare with the obtained data so as to judge

whether the obtained data is the same as previously stored data in the mobile station

10, see col. 6, lines 28-41) ; and

configuring the mobile device to use the first configuration data, when said first

configuration data is present in an entry of the data structure (when the controller 21

recognizes that the detachable SIM card is not exchanged, the mobile station 10 could

connect to the network after going through steps 11-14, see col. 9, lines 54-59 and  col.

10, lines 31-46),

wherein the data structure is stored in an internal memory (memory section 25,

see Fig. 2) of the mobile communications module and the data structure comprises a

plurality of entries that comprise data for respective plurality of identity modules that can

be coupled to the mobile device (network access depends on whether an IC card

attached to the mobile terminal differ from a previously inserted card, see col. 3, lines

29-36 and storing section 252 stores address and corresponding data, the controller

reads data from the storing section to determine whether SIM card 26 has been

exchanged from the mobile terminal, see col. 7, lines 35-62), which inherently suggest

the mobile terminal could store plurality  of IC cards data for subsequent data

comparison; and

wherein the configuration data comprises network access information needed to

allow the mobile device operate in the mobile communications network  using the first

identity module without need for externally programming the mobile device with the

network access information (Sim card 26 stores an International Mobile Subscriber

Identity, IMSI; see col. 7, lines 25-35; i.e. the IMSI is an identity for GSM and UMTS

networks. Furthermore, the mobile station access the communication service network

when data stored on the Sim card is equal to data stored in the memory section of the mobile phone, see col. 6, lines 21-55).

Regarding **claims 2 and 18**, Oshima discloses the method of claims 1 and 17, further comprising:

prompting entry of the first configuration data, when the first configuration data is not present in an entry of the data structure (controller requests a user to input a secret number if the inserted SIM card 26 is different from the previously inserted SIM card 26, see col. 6, lines 42-48).

Regarding **claims 3 and 19**, Oshima discloses the method of claims 2 and 18, further comprising:

storing the first configuration data in a first entry in the data structure, in response to receiving said first configuration data (data and at least one pair of address are stored in the sim card 26, see col. 6, lines 21-41).

Regarding **claims 5 and 20**, Oshima discloses the method of claims 1 and 17, wherein the data structure is stored in a memory module (SIM card 26 stores IMSI number, a PIN number, a telephone of a subscriber, and a short dial data registered by user, see col. 7, lines 25-30).

Regarding **claim 6**, Oshima discloses the method of claim 1, wherein the data structure

is stored in the mobile device (various data stored on sim card are store in the memory

section 25 of the mobile station 10, see, col. 6, lines 21-41).

Regarding **claim 7,** as recited in claim 1, Oshima discloses that the data structure is

stored in a communications network component accessible by the mobile device

(see, col. 6, lines 21-41).


Regarding **claim 11**, Oshima discloses a method of configuring a mobile device

coupled to a first identity module, the method comprising:

detecting a second identity module coupled to the mobile device after the first

identity module (mobile station 10 turns on it's power and read out data to identifies

whether or not the inserted SIM card 26 is equal to the previously inserted SIM card 26,

see col. 7, lines 35-37, Fig. 4A, steps S01-02 and Fig. 6 and see col. 7, lines 35-37

and Fig. 6; whereby the Sim card 26 is being associated with the "first identity module"

and the previous Sim card is also being associated with the "second identity module");

searching a first entry in a data structure (IMSI, PIN and telephone number a

short dial data, col. 7, lines 25-35) for network access information associated with the

second identity module, <u>wherein the data structure is stored in the internal  memory of</u>

<u>the mobile device </u>(see Fig. 4A, steps S01-03 and col. 6, lines 21-51); and

configuring the mobile device according to the network access information in the

first entry to allow the mobile device to operate in a mobile communications network

using the second identity module without need for externally programming the mobile

device with the network access information (Sim card 26 stores an International Mobile

Subscriber Identity, IMSI; see col. 7, lines 25-35; i.e. the IMSI is an identity for GSM and

UMTS networks. Furthermore, the mobile station access the communication service

network when data stored on the Sim card is equal to data stored in the memory section

of the mobile phone, see col. 6, lines 21-55).

Regarding **claim 12**, as cited in claim 11, Oshima discloses the method, wherein the

data structure accommodates multiple entries for storing multiple network access

information corresponding to multiple identity modules configured for coupling with the

mobile device (see col. 6, lines 21-55).

Regarding **claim 13,** as recited in claim 11, Oshima discloses that detecting comprises:

identifying the second identity module based on a second unique value embedded in

the second identity module; and comparing said second unique value with a first unique

value embedded in the first mobile identity module to detect if said first and second

unique values match (inserted Sim card 26 and comparing, see col. 6, lines 21-55).

Regarding **claim 14**, Okkonen further teaches the method of claim 13, further

comprising: determining that the second identity module is other than the first identity

module, when the first and second unique values do not match (inserted Sim card 26

and comparing secret number, see col. 6, lines 21-55).

Regarding **claims 15 and 16**, Oshima discloses the method of claim 13, wherein the second unique value is a serial number and a network ID associated with the second identity module (Sim card 26 stores an International Mobile Subscriber Identity, IMSI; see col. 7, lines 25-35; i.e. the IMSI is an identity for GSM and UMTS networks

4.     **Claims 4 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oshima in view of Lee (U.S. 20040195313 A1), (hereinafter Lee).**

Regarding **claim 4**, as recited in claim 3, Oshima fails to teach storing a reference to the first identity module in a second entry in the data structure, wherein the first entry is associated with the second entry, such that when the first identity module is recoupled to the mobile device after being removed, the reference in the second entry is used to access the first configuration data stored in the first entry.

Lee teaches storing a reference (newly system network set-up information, see Par [0011]) to the first identity module in a second entry in the data structure, wherein the first entry is associated with the second entry, such that when the first identity module is recoupled to the mobile device after being removed, the reference in the second entry is used to access the first configuration data stored in the first entry (newly system network set-up information, is received, stored, compared to the existing data and update the difference, see Par [0011] and Fig. 4).

It would therefore have been obvious to one of the ordinary skill in the art combine the teaching of Lee into the system of Oshima for the benefit of achieving a system whereby network set-up information for a mobile station could be obtained through a service provider.

Regarding **claim 8**, Oshima, as modified by Lee, further discloses the method the method of claim 4, wherein the data structure is in a table format with entries that associate at least one identity module with respective configuration data for said at least one identity module (see Fig 3 and col. 7, lines 35-45).

Regarding **claims 9 and 10,** as recited in claim 1, Oshima fails to teach that first configuration data comprises mobile communication network access point name (APN) and a wireless application protocol internet protocol.

Lee teaches the first configuration data comprises mobile communication network access point name (APN) and a wireless application protocol internet protocol (WAP IP) address (network set-up information includes Wireless application Protocol (WAP) gateway address, and a WAP access point name, see Par. [0024] and Fig. 4).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Lee into the system of Oshima for the benefit of achieving a system whereby network set-up information for a mobile station could be obtained through a service provider.

## Conclusion

5.　　The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Hymel (U.S. 6,216,015)** teaches a wireless subscriber unit and method for smart card data.

**Kirsch et al. (U.S. 20050120225 A1)** teaches a storing and accessing data in a mobile device and a user module.

**Chen et al., (U.S. 20050153741 A1)** teaches a network and method for registration of mobile devices and management of mobile devices.

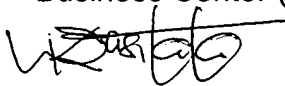**Gibbs et al., (U.S. 20040116109 A1)** teaches automatic wireless device configuration.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kwasi Karikari whose telephone number is 571-272-8566. The examiner can normally be reached on M-F (8 am - 4pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha D. Banks-Harold can be reached on 571- 272 5905. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kwasi Karikari
Patent Examiner.

ERIKA A. GARY
PRIMARY EXAMINER